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EXAMINER

NGUYEN, NHON D

| ART UNIT | PAPER NUMBER |
|----------|--------------|
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2174

DATE MAILED: 07/15/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/627,731

Applicant(s)

MAENG, JOON

Examiner

Nhon (Gary) D Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 April 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- ☐ Interview Summary (PTO-413) Paper No(s). _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other:

DETAILED ACTION

1. This communication is responsive to Amendment A, filed 4/28/2003.
2. Claims 1-26 are pending in this application. Claims 1, 11, 19, and 25 are independent claims. In the Amendment A, claims 1, 3, 11, 19, and 23 are amended. This action is made final.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1, 2, 4, 10, 11-16, 19-21, 25, and 26 are rejected under 35 U.S.C. 102(e) as being anticipated by Ludwig et al ("Ludwig", US #6,343,314).

As per independent claim 1, Ludwig teaches a method of displaying an electronic file to a primary user having a primary workstation, said primary workstation coupled to a global computer network, and at least one secondary viewer at a remote location, comprising:

accessing a first file and displaying said first file on said primary workstation (fig. 37, col. 36, lines 64-65);

displaying said first file at said remote location on a secondary workstation, said secondary workstation coupled to said global computer network (fig. 37, col. 36, lines 64-65);

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accessing a second file, said second file comprising information relating to said first file; and displaying said second file only on said primary workstation as an overlay to said first file, wherein said second file is not viewable by said at least one secondary viewer. According to col. 36, lines 62-64, the Expert (primary user) can create a second file displayed on his workstation and this second file is not viewable by the secondary viewers until he decides to share it.

As per claim 2, which is dependent on claim 1, it is inherent in Ludwig's system that the second file comprises annotations to the first file because the Expert would create the second file in order to support the sharing first file.

As per claim 4, which is dependent on claim 1, Ludwig teaches the first file and the second file are stored in a server computer (col. 28, lines 31-42).

As per claim 10, which is dependent on claim 1, Ludwig teaches activating said first file for editing by said at least one secondary viewer (col. 36, lines 65-67 through col. 37, lines 1-6).

As per independent claim 11, Ludwig teaches a method of synchronous collaboration between a plurality of remote users, each of said plurality of remote users having a user workstation, each of said user workstations being interconnected via a network of interconnected computers, wherein a first one of said plurality of remote users is a host, comprising:

accessing a file for said collaboration, said file having first and second states, in which data stored in said first state is displayed to all of said plurality of remote users, and in which

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data stored in said second state is displayed only to said host as an overlay to said first state; displaying said file on said plurality of user workstations, wherein said data stored in said second state is only displayed to said host, and wherein said data stored in said first state is displayed to said host and to said plurality of remote users. Col. 36, lines 62-65 clearly shows that when the file, generated by the Expert, is not in the shared state (second state), only the Expert can view the file; however, when the file is in the shared state (first state), the Expert and remote clients can view the file.

enabling at least one of said plurality of remote users to edit said data stored in said first state (col. 36, lines 65-67 through col. 37, lines 1-6).

As per claim 12, which is dependent on claim 11, Ludwig teaches the network comprises a videoconference system (col. 10, lines 13-35).

As per claim 13, which is dependent on claim 11, according to Ludwig's system as described in claim 11 above because the file is generated by the Expert, it must be stored in a location remote to any of said plurality of remote users.

As per claim 14, which is dependent on claim 13, Ludwig teaches the file comprises a first file and a second file, wherein said first file comprises said data stored in said first state (share), and said second file comprises said data stored in said second state (not share) (col. 36, lines 62-65).

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As per claim 15, which is dependent on claim 14, it is inherent in Ludwig's system that the first file and said second file are stored in separate memory units.

As per claim 16, which is dependent on claim 15, Ludwig teaches a plurality of third files, each of said plurality of third files comprising a personal file of one of said plurality of remote users (col. 36, lines 59-60).

As per independent claim 19, Ludwig teaches a system for videoconferencing, comprising:

a first workstation having at least a first and second memory unit, said first memory unit adapted to store a first file (fig. 37, col. 36, lines 64-65), said second memory unit adapted to store a second file, said second file comprising information relating to said first file (fig. 37, col. 36, lines 64-65);

at least one video display located remote to said first workstation, said at least one video display interconnected to said first workstation (fig. 18A); and

said first workstation containing programmed instructions to cause the first file to be displayed on both the first workstation and the at least one video display, and to cause the second file to be displayed only on the first workstation as an overlay to said first file. According to col. 36, lines 62-64, the Expert (primary user) can create a second file displayed on his workstation and this second file is not viewable by the secondary viewers until he decides to share it.

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As per claim 20, which is dependent on claim 19, because Ludwig's system is a video conferencing system, it is inherent for the system to have VGA memories.

As per claim 21, which is dependent on claim 20, it is similar scope to claim 2; therefore, it should be rejected under similar rationale.

As per independent claim 25, it is a similar scope to claim 1; therefore, it should be rejected under similar rationale.

As per claim 26, which is dependent on claim 25, Ludwig teaches the machine-readable storage medium includes any of magnetic storage medium, including disk and tape storage medium; optical storage medium, including compact disk memory and digital video disk storage medium; nonvolatile memory storage memory; volatile storage medium; and modulated, electronic signals (col. 30, lines 30-67 through col. 31, lines 1-67 and through col. 32, lines 1-44).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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6. Claims 3, 5-9, 17, 18, and 22-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ludwig in view of Kumar et al ("Kumar", US #6,342,906).

As per claim 3, which is dependent on claim 2, Ludwig does not disclose the displaying further comprises displaying said first file on plural secondary workstations and wherein the second file is displayed as an overlay to said first file on selected but not all of said plural secondary workstations. Kumar discloses in col. 2, lines 37-57 that an authorized user in a network can mark the annotation layer to the shared file while at the same time can block the other participants from editing the share file. It would have been obvious to an artisan at the time of the invention to use the teaching from Kumar of displaying the second file as an overlay to the first file in Ludwig's method since it would allow the user to put notes or comment on the first file.

As per claim 5, which is dependent on claim 4, Ludwig does not disclose said first file and said second file are a single file, and further wherein said second file contains a code to indicate that said second file is not for display at said secondary workstation. According to Kumar in col. 2, lines 29-37, annotation layer is a file combined of different files and at the option of the participants, the annotation layer can be visible or invisible (depends on the code to indicate that it can be visible or invisible). It would have been obvious to an artisan at the time of the invention to use the teaching from Kumar of said first file and said second file are a single file, and further wherein said second file contains a code to indicate that said second file is not for display at said secondary workstation in Ludwig's method since it would serve as security purposes.

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As per claim 6, which is dependent on claim 3, it is inherent in Ludwig system that the Expert's workstation (primary workstation) comprises a plurality of memory units, and wherein said first file is stored in a first memory unit and said second file is stored in a second memory unit.

As per claim 7, which is dependent on claim 6, this claim is rejected under the same rationale as claim 3.

As per claim 8, which is dependent on claim 7, Ludwig teaches the global computer network comprises a video conferencing system (col. 10, lines 13-35).

As per claim 9, which is dependent on claim 3, Ludwig teaches the primary user comprises a customer service representative (*the Expert*, col. 36, lines 48-50) and said secondary viewer comprises a customer (*client*, col. 36, lines 48-50), and the internet is a global network connecting millions of computer.

As per claim 17, which is dependent on claim 16, it is rejected under the same rationale as claim 3.

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As per claim 18, which is dependent on claim 17, Ludwig teaches a common annotation file, said common annotation file relating to said first file and accessible by more than one of said plurality of remote users (col. 36, lines 65-67 through col. 37, lines 1-6).

As per claims 22, 23 and 24, which are dependent on claims 21, 20 and 19 respectively, they are rejected under the same rationale as claim 3.

Response to Arguments

7. Applicant's arguments filed 4/28/2003 have been fully considered but they are not persuasive.

Applicants argued the following:

(a) Neither Ludwig nor Kumar teach suggest or disclose a method or system having an "overlay" or "annotations" displayed over a first file at a primary workstation and "not viewable" on a secondary workstation.

(b) No motivation exists to combine the disclosures of Ludwig and Kumar to suggest such an overlay or annotation layer on a primary workstation that is not viewable on a secondary workstation.

(c) Ludwig fails to disclose any editing of its client profile displayed on the expert or any motivation to display the client profile as an overlay or annotation.

(d) Kumar's abstract explicitly teaches away from Applicant's claimed invention by stating "The applications and the data are synchronized among all clients to display the same view."

The Examiner disagrees for the following reasons:

(a) Ludwig does teach a method or system having an “overlay” or “annotations” displayed over a first file at a primary workstation and “not viewable” on a secondary workstation. According to Ludwig in col. 36, lines 61-67 through col. 37, lines 1-13, “the Expert illustrates his advice by creating (using his own modeling software) and sharing a new graphical image 220 (FIG. 37) with the field representative and his client.” At the time that the Expert creates his own image (221 of fig. 37), which comments about the first discussed image (220 of fig. 37), only he himself can view this image. The field representative and his client (secondary workstation) cannot view this image until the Expert decides to share it (col. 36, lines 53-58). The new created image (221 of fig. 37) is in fact an “overlay” or “annotation” displayed over the first image file (210 of fig. 36). The Examiner also takes further notice that the expert can bring up the same first image file (210 of fig. 36), from his saved storage (col. 37, line 11), and annotate over that image with his own comments (e.g. 222 of fig. 37); of course, the field representative and his client, on the secondary workstation, cannot see that overlaid annotated image until the Expert decides to share it.

It is noticed that the claimed language appears not to describe clearly the claimed invention. According to the invention, the claimed language should read like overlay the content, not the file, of the second file over the content of the first file. Also, the invention is about “transparent overlay” while the claimed language is only about “overlay”. It is noticed that these two terms have different implication.

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(b) In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, both Ludwig and Kumar's systems are real-time collaboration across remote sites in which data can be shared in a common workspace by a method of annotation layer.

(c) The Office Action does not mention about "client profile" feature.

(d) Kumar's abstract only briefly states "The applications and the data are synchronized among all clients to display the same view." However, that is only an overall statement. In fact, Kumar's specification does state in detail that "At the option of the participants, the annotation layer can be synchronized with the work space underneath or it can be left unsynchronized... When the annotation layer is left unsynchronized, then scrolling the work space does not scroll the annotation layer" (Col. 2, lines 11-22). Furthermore, Kumar discloses, "At the option of the participant, the covering annotation layer can be visible or invisible in the edit mode. In both edit and discussion modes, the transparent layer an the work space underneath can be made synchronized or unsynchronized. The mode of any participant can be decided and/or changed by the participant alone, and/or by other participants. The participants with authority to control/restrict/change other participants' modes can be a subset of the participants in the collaboration session." (Col. 2, lines 43-51). Therefore, Kumar's indeed does not teach away from Applicant's claimed invention

Conclusion

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Inquiries

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nhon (Gary) D Nguyen whose telephone number is 703-305-8318. The examiner can normally be reached on Monday - Friday from 8 AM to 5:30 PM with every other Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kistine L Kincaid can be reached on 703-308-0640. The fax phone numbers for the organization where this application or proceeding is assigned are 703-746-7239 for regular communications and 703-746-7238 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

Nhon (Gary) Nguyen
July 14, 2003

Kristine Kincaid
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